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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,673	07/20/2001	Yoram Yaacovi	MSFT-0314/164088.1	1516

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EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

3621

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/909,673

Applicant(s)

YAACOVI, YORAM

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-13 and 47-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-13, 50, 52-56, 60 and 61 is/are rejected.
- 7) ☒ Claim(s) 51 and 62 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office is in response to Applicant's amendment filed on 09/25/2006.
2. Claims 7-13 and 47-62 are pending.

### *Allowable Subject Matter*

3. Claims 51 and 62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-13, 47-50 and 52-61 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Stefik (U.S. pat. No. 5,715,403) in view of the newly found prior art Tadayon et al (U.S. Pat. No. 6,876,984, filed on May 31, 2001).

As per claim 7-13, 50, 52-56 and 60-61 Stefik substantially discloses the claimed method wherein the content package comprises a content portion and the first license ( or repository, figs 1 and 2), and wherein said licensing act comprises:

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Receiving first data indicative of a first digital license, wherein the first digital license specifies one or more terms governing the relicensing of the first content package, wherein the first digital license is associated with the first content package and permits access to the first content package on a second computing device but not on the first computing device, and wherein the first content package is usable only in accordance with one or more digital licenses, said first digital license being one of said one or more digital licenses, and licensing the first content package for use on the first computing device in accordance with said one or more terms, Creating a second content package which comprises:

Said content portion (or repository); and

A second (or usage rights associated with repository 2) which permits access to said second content package on the first computing device (see., col 7, lines 16-48, figs 1 and 2); and transmitting said second content package to the first computing device (see., col 2, lines 21-44, col 9, lines 19-31, col 44, lines 33-55, col 7, lines 16-48, figs 1 and 2, col 8, lines 1-32).

Stefik fails to explicitly disclose a payment is a condition for licensing content and revoked or made unusable as a condition for issuing a different license as recited in claim 49.

Tadayon discloses a usage rights for a digital work where the usage right associated with the digital work and/ or license are checked to determine whether all the conditions, such as payment, associated with the usage rights have been satisfied, otherwise revoked rights (see., abstract, col 4, lines 31-58). It would have been obvious to a

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person of ordinary skill in the art at the time the invention was made to modify the teaching of Stefik by including the limitation detailed above as taught by Tadayon because this would determine that the payment associated to the license is verified.

As per claims 47, 48 and 57-59 Stefik discloses the claimed method of determining that licensure of the first content package for use on the first computing device is consistent with a first of said one or more terms (see., abstract, col 2, lines 21-44, col 9, lines 19-31, col 44, lines 33-55, and one or more terms or conditions see., col 4, lines 14-24, specifically conditions to exercising the right or if license fees have not been paid).

#### **RESPONSE TO ARGUMENTS**

6. Applicant's arguments filed on 09/25/2006 have been fully considered but they are not persuasive.

#### **REMARKS**

7. In response to claims 7-13, Applicant argues that the undersigned and the Examiner's supervisor, Andrew Fischer, have discussed this case on several occasions during August and September 2006. It was agreed that a claim based on a combination of the feature of claims 1 and 7 would be favorably considered. However, the Examiner respectfully disagrees because claim 7 as is, is not in condition for allowance.

Therefore, in order to place this application in condition for allowance, Applicant is advised to incorporate the limitation of claim 51 and claim 62 into the independent claims.

**NOTE**

8. The formal drawings have been accepted. Furthermore, if the Applicant has any questions or believes a telephone conference would expedite prosecution of this application, the Applicant is encouraged to call the Examiner at (571) 272 6706.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571 272 6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**Pierre Eddy Elisca**

**Primary Examiner**

**November 30, 2006**